

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 56

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEANE SEGALL and LEONARD M. SHORR

Appeal No. 2001-0452
Application 08/073,969

HEARD: APRIL 3, 2001

Before WINTERS, SCHEINER, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

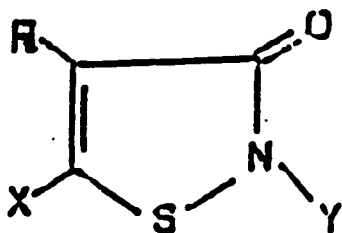
Initially, we note the examiner's statement in the Final Rejection that claims 27 through 31 and 38 through 67 are the only claims pending in this application (Paper No. 41, mailed September 3, 1999). Likewise, applicants' Notice of Appeal (Paper No. 43, received January 3, 2000) refers only to claims 27 through 31 and 38 through 67 and the Appeal Brief, page 1, states that those claims "are present in the case and are on appeal" (Paper No. 46, received March 28, 2000). According to applicants and the examiner, therefore, the only claims presented for review are claims 27 through 31 and 38 through 67.

We point out, nonetheless, that there are other claims pending in the application,

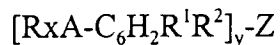
viz., claims 2 through 7, 13 through 15, 17 through 22, and 37. As best we can judge from a review of the file wrapper, those claims have never been canceled even though they form no part of the appeal before us. On return of this application to the Examining Corps, we suggest that applicants and the examiner clarify the status of claims 2 through 7, 13 through 15, 17 through 22, and 37.

Claims 38, 39, and 40, which are illustrative of the subject matter on appeal, read as follows:

38. A stabilized composition comprising an aqueous solution of one or more 3-isothiazolinones of the Formula (I)



wherein X represents hydrogen or a halogen, Y is an alkyl, alkenyl, cycloalkyl, aralkyl or aryl group and R is hydrogen, halogen or an alkyl radical,
and stabilizing amount of a compound of the formula:



wherein:

R, R^1 and R^2 each independently represents hydrogen, a straight-chained or branched or cyclic alkyl radical, aralkyl or aryl;

A is oxygen or nitrogen;

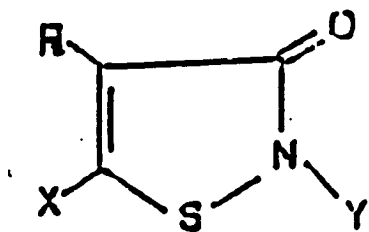
C_6H_2 is a phenyl ring which may be substituted;

Z represents Ar_x, R^1, R^2 , alkoxy methylene or alkylidene;

provided that when A is oxygen, x is 0 or 1 and when A is nitrogen, x is 1 or 2; and y is 1 or 2;

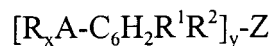
wherein the total content of 3-isothiazolinones is below 8 wt/% and which contains no more than 10 wt% isothiazolinone decomposition products. [Emphasis added.]

39. A stabilized composition comprising an aqueous solution of one or more 3-isothiazolinones of the Formula (I)



wherein X represents hydrogen or a halogen, Y is an alkyl, alkenyl, cycloalkyl, aralkyl or aryl group and R is hydrogen, halogen or an alkyl radical,

and stabilizing amount of a compound of the formula:



wherein:

R, R^1 and R^2 each independently represents hydrogen, a straight-chained or branched or cyclic alkyl radical, aralkyl or aryl;

A is oxygen or nitrogen;

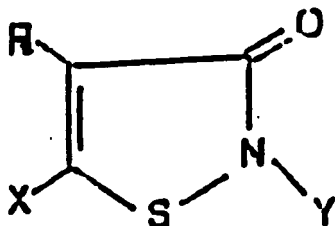
C_6H_2 is a phenyl ring which may be substituted;

Z represents Ar_x, R^1, R^2 , alkoxy methylene or alkylidene;

provided that when A is oxygen, x is 0 or 1 and when A is nitrogen, x is 1 or 2; and y is 1 or 2;

wherein the total content of 3-isothiazolinones is below 8 wt/% and wherein the composition has a stability period of at least 100 days. [Emphasis added.]

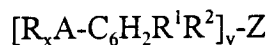
40. A stabilized composition comprising an aqueous solution of one or more 3-isothiazolinones of the Formula (I)



wherein X represents hydrogen or a halogen, Y is an alkyl, alkenyl, cycloalkyl, aralkyl

or aryl group and R is hydrogen, halogen or an alkyl radical,

and a stabilizing amount of a compound of the formula:



wherein:

R, R¹ and R² each independently represents hydrogen, a straight-chained or branched or cyclic alkyl radical, aralkyl or aryl;

A is oxygen or nitrogen;

C₆H₂ is a phenyl ring which may be substituted;

Z represents Ar_x, R¹, R², alkoxy methylene or alkylidene;

provided that when A is oxygen, x is 0 or 1 and when A is nitrogen, x is 1 or 2; and y is 1 or 2;

wherein the total content of 3-isothiazolinones is below 8 wt/% and which contains no more than 10 wt.% isothiazolinone decomposition products and wherein the composition has a stability period of at least 100 days. [Emphasis added.]

The prior art references relied on by the examiner are:

Segall et al. (Segall) 4,920,137 Apr. 24, 1990

Hart et al. (Hart), Organic Chemistry A Short Course, 6th ed., Houghton Mifflin Co., Boston, Mass., pp. 227 & 282-283, 1995

Claims 27 through 31 and 38 through 67 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Segall alone or the combined disclosures of Segall and Hart

(Examiner's Answer, paragraph bridging pages 3 and 4). Further, claims 38, 40, 45, 49, 54, 58, 63, and 67 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure (Examiner's Answer, page 4, first full paragraph); and claims 38 and 40 stand rejected under 35 U.S.C. § 112, second paragraph, as not particularly pointing out and distinctly claiming the subject matter which applicants regard as their invention (Examiner's Answer, page 4, second complete paragraph).

On consideration of the record, we reverse each of the examiner's rejections.

Discussion

This is not a close case, and we shall not belabor the record with extensive comment.

Respecting the rejection under 35 U.S.C. § 103, the examiner argues that:

It would have been obvious to one skilled in the art at the time the invention was made to have tried varying wt. % of 3-isothiazolinones as taught by Segall et al. in combination with varying percentages of known stabilizing compounds as taught by Segall et al. A skilled artisan would have been motivated to do so by the prior art teachings in order to optimize conditions for increased isothiazolinone stability and shelf-life. [Examiner's Answer, mailed May 17, 2000, page 5, last paragraph; emphasis added].

That argument, however, does not explain how a person having ordinary skill in the art would have been led from "here to there," i.e., from the disclosure of Segall alone or the combined disclosures of Segall and Hart to the claimed subject matter considered as a whole. Further, that argument is predicated on an incorrect standard of patentability. As

stated in American Hospital Supply Corp. v. Travenol Labs., Inc., 745 F.2d 1, 7, 223 USPQ 577, 582 (Fed. Cir. 1984), “‘obvious to try’ is not a legitimate test of patentability under section 103” [footnote omitted].

Further, in resolving questions of obviousness, it is imperative that the examiner consider applicants’ claimed subject matter as a whole. 35 U.S.C. § 103. As stated in In re Geerdes, 491 F.2d 1260, 1262, 180 USPQ 789, 791 (CCPA 1974), every limitation in the claims must be given effect. This the examiner has not done. On the contrary, the examiner fixates on a previous Board opinion in this application (Paper No. 33, mailed March 31, 1998). In the previous opinion, another merits panel of the Board found that Segall constitutes a technical anticipation of the sole independent claim then pending (claim 37). For that reason, and because lack of novelty in the claimed subject matter is the ultimate or epitome of obviousness, the previous merits panel affirmed the examiner’s decision rejecting claim 37 under 35 U.S.C. § 103 as unpatentable over Segall. Dependent claims 2 through 7, 13 through 15, and 17 through 22 fell together with independent claim 37 in the previous decision, because the former were not argued separately from the latter.

In the present appeal, the examiner steadfastly relies on reasoning set forth by the previous merits panel. See the Examiner’s Answer mailed May 17, 2000, page 7, first full paragraph (“The instant claims . . . are not rejected for a different reason than found in the Board of Appeals’ decision in Paper No. 33, but for the same reason”); and page 9, first

full paragraph (“It is submitted that the Board of Appeals’ reasoning and decision in Paper No. 33 for rejected claim 37, which forms the basis of the independent claims 38-40 in this Continued Prosecution Application, is equally applicable to the instant application”). That reliance is misplaced and the examiner’s argument is flawed because independent claims 38, 39, and 40 before us contain significant limitations not present in previously submitted claim 37. Independent claim 38, like previously submitted claim 37, requires that the total content of 3-isothiazolinones is below 8 wt. %, but claim 38 also requires that the claimed composition contains no more than 10 wt. % isothiazolinone decomposition products. By the same token, claim 39 requires that the total content of 3-isothiazolinones is below 8 wt. %, but claim 39 also requires that the composition has a stability period of at least 100 days. Claim 40 sets forth all three limitations at the end of the claim, viz., a composition wherein the total content of 3-isothiazolinones is below 8 wt. % and which contains no more than 10 wt. % isothiazolinone decomposition products and wherein the composition has a stability period of at least 100 days.

In a nutshell, the examiner erred by not adequately re-evaluating patentability in light of the newly presented independent claims. Cf. In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986) (“If a prima facie case [of obviousness] is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter

are to be reweighed.”) On this record, the examiner does not explain how Segall constitutes a technical anticipation of independent claims 38, 39, and 40. Nor does the examiner explain how the disclosure of Segall alone, or the combined disclosures of Segall and Hart, would have suggested the subject matter of claims 38, 39, or 40, taking into account all of the limitations recited in those claims.

The examiner’s decision, rejecting claims 27 through 31 and 38 through 67 under 35 U.S.C. § 103(a), is reversed.

The examiner also sets forth non-prior art rejections in this case. Claims 38 and 40 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure in view of the expression “which contains no more than 10 wt. % isothiazolinone decomposition products.” Those same claims stand rejected under 35 U.S.C. § 112, second paragraph, as not particularly pointing out and distinctly claiming the subject matter which applicants regard as their invention in view of the same expression.¹ In our judgment, those rejections are untenable for the reasons succinctly stated in the Appeal Brief (Paper No. 46), pages 13 through 15.

The examiner’s decision, rejecting claims 38 and 40 under 35 U.S.C. § 112, first and second paragraphs, is reversed.

¹ We note in passing the rejection, initially set forth, of claims 45, 49, 54, 58, 63, and 67 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure in view of the expression “and a mixture of NaNO_3 and KNO_3 ” (Examiner’s Answer, page 4, first full paragraph). However, it appears that the examiner subsequently withdrew that rejection (Examiner’s Answer, page 11, first full paragraph), and we find it unnecessary to discuss it further.

Appeal No. 2001-0452
Application 08/073,969

For the reasons set forth in the body of this opinion, we do not sustain the examiner's prior art or non-prior art rejections. The examiner's decision, rejecting claims 27 through 31 and 38 through 67, is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

Toni R. Scheiner
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

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